

Response under 37 C.F.R. 1.116

Applicant: Craig McCoy et al.

Serial No.: 09/810,174

Filed: March 15, 2001

Docket No.: 10004231-1 (H302.153.101)

Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK SERVER DEVICE

REMARKS

The following remarks are made in response to the Final Office Action mailed November 10, 2004. In that Office Action, the Examiner rejected claims 1-8, 10-15, 17-24, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Anderson, U.S. Patent No. 6,427,165 ("Anderson"), in view of Alexander et al., U.S. Patent No. 6,134,593 ("Alexander"). Claims 9, 16, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Alexander, and further in view of Barrett et al., U.S. Patent No. 5,647,056 ("Barrett").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1-29. Claims 1-29 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1-8, 10-15, 17-24, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Anderson, U.S. Patent No. 6,427,165 ("Anderson"), in view of Alexander et al., U.S. Patent No. 6,134,593 ("Alexander"). Anderson and Alexander, either alone, or in combination, do not teach or suggest "a method of installing components of a software product on a first network server device coupled to a network, the components of the software product providing the first network server device the capability to provide a first service to a plurality of server assisted network devices coupled to the network", as recited in independent claim 1. The Examiner stated that "[r]egarding claim 1, Anderson discloses a method (7:56 – 9:19) ... of installing components of a software product" (Office Action at para. no. 4, page 2). The method disclosed in Anderson referred to by the Examiner discloses a method for selectively obtaining *information* over a network with an information handling system, and does not teach or suggest *installing components of a software product* to provide a *first service to a plurality of server assisted network devices*.

In a Response to Arguments section of the Final Office Action, the Examiner stated that:

Applicants arguments filed 08/05/2004 have been fully considered but they are not persuasive.

Response under 37 C.F.R. 1.116

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Argument (1), Applicant argues on page 9 of response dated 08/05/2004 that in claims 1, 14, and 17 neither Anderson nor Alexander discloses "a method of installing components of a software product on a first network server device coupled to a network, the components of the software product providing the first network server device the capability to provide a first service to a plurality of server assisted network devices".

Response (1), Examiner believes that Anderson does in fact disclose this functionality. As set forth above in claims and as disclosed in Anderson in 7:5 – 8, Anderson discloses obtaining updates and needed programs by downloading the information into a handling system 100. The handling system as then processes the downloaded content as discussed in 3: 7-20. Examiner interprets installing to be loading and processing or executing and Anderson does perform that. (Final Office Action at para. no. 6, pages 7-8).

Anderson at 7:5-8, which was cited by the Examiner in the Response to Arguments, discloses an embodiment in which information is "pushed" to information handling system 100. There is no teaching or suggestion in Anderson that the information handling system 100 is a network server device, or that the "information" that is pushed to information handling system 100 includes components of a software product that provide the information handling system 100 with the capability to provide a service to a plurality of server assisted network devices.

Anderson at 3:7-20, which was also cited by the Examiner in the Response to Arguments, discloses that information handling system 100 can include various types of memories, and includes the statement "[m]ain memory 104 provides storage of instructions and data for programs executing on central processor 102." There is no teaching or suggestion in Anderson that the information handling system 100 is a network server device, or that any of the programs executing on central processor 102 provide the information handling system 100 with the capability to provide a service to a plurality of server assisted network devices.

As shown in the above block quote, the Examiner set forth an "Argument (1)" and a "Response (1)". Thus, it appears that the Examiner may have intended to respond to the numerous other arguments set forth in the previously filed Response by the Applicant, but the Examiner did not provide an "Argument (2)" and a "Response (2)", an "Argument (3)" and a "Response (3)", etc. The Examiner did not respond to any of the other remarks provided by

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the Applicant, including the remarks that the cited prior art does not teach or suggest “automatically detecting with the first network server device a first set of server-assisted network devices coupled to the network that are eligible to use the first service”, “automatically transmitting device information based on the detected server-assisted network devices to a second network server device”, “receiving license information from the second network server device based on the transmitted device information”, and “automatically installing components of the software product on the first network server device”, as recited in independent claim 1. Thus, Applicant again addresses these limitations below.

Anderson and Alexander, either alone, or in combination, do not teach or suggest “automatically detecting with the first network server device a first set of server-assisted network devices coupled to the network that are eligible to use the first service”, as recited in independent claim 1. In the Final Office Action, the Examiner repeated the statement from the first Office Action that this limitation is disclosed at 6:45-50 of Anderson. (Office Action at para. no. 4, page 2). Anderson at 6:45-50 discloses that “[a]fter executing any of steps 410, 412 or 414, a list of relevant nodes or servers on the network that contain relevant information may be obtained at step 416. Each of the nodes on the network may be sampled at step 418 for a specific, predetermined parameter value such as connection rate, for example.” The predetermined parameters of Anderson refer to parameter values of nodes where requested information can be obtained. The parameter values include values such as connection speed, download time, time of node availability, node capacity, node loading, etc. (See, e.g., Anderson at col. 4, lines 49-53). The predetermined parameter values do not identify *server-assisted network devices* coupled to the network that are *eligible* to use the *first service*.

There is no teaching or suggestion in Anderson that information handling system 100 is a network server device. There is no teaching or suggestion in Anderson that any of the nodes accessed by information handling system 100 are server-assisted network devices. The present application states that “Server-assisted network devices 101 according to the present invention include any network device that relies on a server on a network to provide some functionality. Server-assisted network devices 101 may be printers, scanners, PCs, digital senders, and any other network device that relies on a server to provide some functionality.” (Specification at page 4). There is no teaching or suggestion in Anderson that any of the

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Docket No.: 10004231-1 (H302.153.101)

Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK SERVER DEVICE

nodes relies on a server to provide some functionality. There is no teaching or suggestion in Anderson that information handling system 100 automatically detects server-assisted network devices coupled to the network that are eligible to use a service to be provided by the information handling system 100.

Anderson and Alexander, either alone, or in combination, do not teach or suggest "automatically transmitting device information based on the detected server-assisted network devices to a second network server device", as recited in independent claim 1. The Examiner indicated that this limitation is disclosed in column 7, lines 4-10 of Anderson, which states: "Such an application may be for content 'pushing' type programs that may be constantly updated wherein the program automatically gathers information from the network and downloads the information to information handling system 100 without intervention by the user. The nodes or servers from which information is pushed to information handling system 100 may be based upon the predetermined parameter values, and not merely upon content of the nodes alone."

As pointed out above, there is no teaching or suggestion in Anderson that information handling system 100 is a network server device, or that information handling system 100 automatically detects server-assisted network devices coupled to the network that are eligible to use a service to be provided by the information handling system 100. Since information handling system 100 does not detect such server-assisted network devices, information handling system 100 cannot transmit device information "based on the detected server-assisted network devices". Anderson does not teach or suggest automatically transmitting *device information* based on the *detected server-assisted network devices* to a *second network server*.

Anderson and Alexander, either alone, or in combination, do not teach or suggest "receiving license information from the second network server device based on the transmitted device information", as recited in independent claim 1. The Examiner acknowledged that Anderson does not disclose receiving license information from the second network server device based on the transmitted device information. (Office Action at para. no. 4, page 3). The Examiner stated that Alexander discloses an installer identifier that identifies licensing information for verification purposes during installing in a distributed environment. (Office Action at para. no. 4, page 3). However, like Anderson, there is no

Response under 37 C.F.R. 1.116

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Docket No.: 10004231-1 (H302.153.101)

Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK SERVER DEVICE

teaching or suggestion in Alexander that the "client" computing device 110 is a network server device, or that the client computing device 110 automatically detects server-assisted network devices coupled to a network that are eligible to use a service to be provided by the client computing device. Since client computing device 110 does not detect such server-assisted network devices, client computing device 110 cannot transmit device information "based on the detected server-assisted network devices". Alexander does not teach or suggest automatically transmitting *device information* based on the *detected server-assisted network devices* to a *second network server*. Therefore, the system disclosed in Alexander does not receive license information based on transmitted *device information*.

Anderson and Alexander, either alone, or in combination, also do not teach or suggest "automatically installing components of the software product on the first network server device", as recited in independent claim 1. The Examiner stated that this limitation is disclosed in column 7, lines 5-8 of Anderson, which state: "Such an application may be for content 'pushing' type programs that may be constantly updated wherein the program automatically gathers information from the network and downloads the information to information handling system 100 without intervention by the user." There is no teaching or suggestion in Anderson that the information handling system 100 is a network server device, or that the "information" that is pushed to information handling system 100 includes components of a software product that provide the information handling system 100 with the capability to provide a service to a plurality of server assisted network devices. Anderson does not teach or suggest *installing components of the software product on a network server device*.

In view of the above, Anderson and Alexander do not teach or suggest each and every limitation of independent claim 1. There is also no teaching or suggestion to combine Anderson with Alexander. The Federal Circuit has stated "[i]n holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." *Karsten Manufacturing Corp. vs. Cleveland Golf Co.*, 58 U.S.P.Q.2d 1286, 1293 (CAFC 2001). Anderson relates to information gathering while Alexander relates to automatically ordering and unlocking software on a user's system. The two disclosures are in two different technical

Response under 37 C.F.R. 1.116

Applicant: Craig McCoy et al.

Serial No.: 09/810,174

Filed: March 15, 2001

Docket No.: 10004231-1 (H302.153.10J)

Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK SERVER DEVICE

areas and are not related to one another. There is no suggestion to combine the references in any manner, let alone in a manner that would produce the claimed invention.

In view of the above, independent claim 1 is not taught or suggested by Anderson and Alexander, either alone, or in combination. The Applicant respectfully traverses the rejection of claim 1, and reconsideration and allowance of claim 1 is respectfully requested. Dependent claims 2-8 and 10-13 further limit patentably distinct claim 1, are further distinguishable over the cited prior art, and are believed to be allowable over the cited references. Reconsideration and allowance of claims 2-8 and 10-13 is respectfully requested.

Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 14. Independent claim 14 recites a network server device configured to facilitate the installation of components of a software product, the components of the software product providing the network server device the capability to provide a first service to a plurality of server-assisted network devices coupled to the network. The network service device comprises a controller configured to automatically detect a first set of server-assisted network devices coupled to the network that are eligible to use the first device, a transmitter for automatically transmitting device information based on the detected server-assisted network devices to a second network server device, and a receiver for receiving license information from the second network server device based on the transmitted device information. The controller is further configured to automatically install components of the software product on the network server device.

For the same reasons as discussed above with reference to claim 1, Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 14. The Applicant respectfully traverses the rejection of claim 14, and reconsideration and allowance of claim 14 is respectfully requested. Dependent claim 15 further limits patentably distinct claim 14, is further distinguishable over the cited prior art, and is believed to be allowable over the cited references. Reconsideration and allowance of claim 15 is respectfully requested.

Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 17. Independent claim 17 recites a computer readable medium having computer-executable instructions for performing a method of installing components of a software product on a first network server device coupled to a network, the

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Serial No.: 09/810,174

Filed: March 15, 2001

Docket No.: 10004231-1 (H302.153.101)

Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK SERVER DEVICE

components of the software product providing the first network server device the capability to provide a first service to a plurality of server-assisted network devices coupled to the network. The method comprises automatically detecting with the first network server device a first set of server assisted network devices coupled to the network that are eligible to use the first service, automatically transmitting device information based on the detected server-assisted network devices to a second network server device, receiving license information from the second network server device based on the transmitted device information, and automatically installing components of the software product on the first network server device.

For the same reasons as discussed above with reference to claim 1, Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 17. The Applicant respectfully traverses the rejection of claim 17, and reconsideration and allowance of claim 17 is respectfully requested. Dependent claims 18-24 and 26-29 further limit patentably distinct claim 17, are further distinguishable over the cited prior art, and are believed to be allowable over the cited references. Reconsideration and allowance of claims 18-24 and 26-29 is respectfully requested.

The Examiner rejected claims 9, 16, and 25 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Alexander, and further in view of Barrett et al., U.S. Patent No. 5,647,056 ("Barrett").

Dependent claim 9 depends upon independent claim 1. Dependent claim 16 depends upon independent claim 14. Dependent claim 25 depends upon independent claim 17. As described above, Anderson and Alexander do not teach or suggest several limitations of claims 1, 14, and 17. Barrett also does not teach or suggest these limitations of claims 1, 14, and 17. In view of the above, claims 9, 16, and 25, which further limit patentably distinct claims 1, 14, and 17, respectively, and are further distinguishable over the cited prior art, are believed to be allowable over the cited references. Reconsideration and allowance of claims 9, 16, and 25 is respectfully requested.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-29 are in form for allowance and are not taught or suggested by the cited references. Therefore,

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Applicant: Craig McCoy et al.

Serial No.: 09/810,174

Filed: March 15, 2001

Docket No.: 10004231-1 (H302.153.101)

Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK SERVER DEVICE

reconsideration and withdrawal of the rejections and allowance of claims 1-29 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Jeff D. Limon at Telephone No. (541) 715-5979, Facsimile No. (541) 715-8581 or Jeff A. Holmen at Telephone No. (612) 573-0178, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to Fax No. (703) 872-9306, Attention Examiner Chuck O. Kendall of Group Art Unit 2100, on this 6th day of January, 2005.

By *Jeff A. Holmen*
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